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Paper 352
Filed: 27 April 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

JOHN C. **MITCHELL**, ALAN J. HEARD,
STEVEN N. CORBETT, and NICHOLAS J. DANIEL
Junior Party
(Patent No. 5,799,273),

v.

DOUGLAS **HOLT**, MICHAEL K. DAVIS,
and JOSEPH H. MIGLIETTA

Senior Party
(Application No. 09/351,542).

Patent Interference No. 105,746
(Technology Center 2600)

Before JAMESON LEE, SALLY GARDNER LANE, and SALLY C. MEDLEY,
Administrative Patent Judges.

MEDLEY, *Administrative Patent Judge.*

DECISION –MOTIONS – Bd.R. 125(a)

A. Introduction

This interference is before us to decide the preliminary motions filed. Mitchell Motion 2 seeks judgment against Holt on the basis that all of Holt's involved claims are unpatentable under the written description requirement of 35 U.S.C. § 112, ¶ 1 (Paper 73). Mitchell Motion 3 seeks judgment against Holt on the basis that Holt claims 51-57, 59-62, 82-88 and 93 are unpatentable under 35 U.S.C. § 112, ¶ 2 (Paper 74). Through Mitchell Motion 4, Mitchell seeks judgment against Holt on the basis that Holt claims 51, 52, 54, 56, 57, 59-62, 76, 78, 80 and 84 are unpatentable under 35 U.S.C. § 135(b)(1) (Paper 68). Mitchell Motion 5 seeks to designate Mitchell claims 60-63 as not corresponding to Count 1 (Paper 76). Mitchell Motion 6 seeks judgment against Holt on the basis that all of Holt's involved claims are unpatentable under the enablement requirement of 35 U.S.C. § 112, ¶ 1 (Paper 77). Mitchell also filed a motion to exclude (Paper 137).

Holt Motion 1 seeks judgment against Mitchell on the basis that all of Mitchell's involved claims are unpatentable under 35 U.S.C. 102(e)/103 based on Holt patent 5,960,447 (Paper 33). Holt Motion 2 seeks judgment against Mitchell on the basis that all of Mitchell's involved claims are unpatentable based on 35 USC 102/103 based on sale of a product (Paper 44). Holt Motion 3 seeks judgment against Mitchell on the basis that all of Mitchell's involved claims are unpatentable under the enablement requirement of 35 U.S.C. § 112, ¶ 1 (Paper 34). Holt Motion 4 seeks judgment against Mitchell on the basis that Mitchell claims 60-63 are unpatentable under 35 U.S.C. § 112, ¶ 2 (Paper 35). Holt Motion 5 seeks judgment against Mitchell on the basis that Mitchell claims 1-5, 7, 9, 14-16, 18, 21, 22, 24, 25, 27, 60-70, 75 and 76 are unpatentable under paragraphs 2 and 6 of 35

U.S.C. § 112 (Paper 36). Holt Motion 6 seeks to add proposed Holt claim 95 to the interference and to designate that claim as corresponding to Count 1 (Paper 82).

Oral argument was held January 13, 2011.

For the reasons that follow, Mitchell Motion 2 is GRANTED; Mitchell Motions 3-6 are DISMISSED; Mitchell Motion 7 is GRANTED-IN-PART and DISMISSED-IN-PART; Holt Motions 1-5 are DISMISSED and Holt Motion 6 is DENIED.

B. Findings of fact[1]

1. Mitchell is involved on the basis of patent 5,799,273, granted 25 August 1998, based on application 08/720,373, filed 27 September 1996.

2. Holt is involved on the basis of application 09/351,542, filed 12 July 1999.

3. Holt has been accorded benefit for the purpose of priority of application 08/556,077, filed 13 November 1995, now patent 5,960,447, issued 28 September 1999 (Paper 1 at 4).

4. Mitchell's real party in interest is Allvoice Developments US, LLC (Paper 9).

5. Holt's real party in interest is Advanced Voice Recognition Systems, Inc. (Paper 4).

6. The count is claim 28 or claim 51 or claim 71 or claim 73 or claim 77 of Mitchell patent 5,799,273 (Paper 1 at 4).

7. Mitchell claim 71 is one alternative of the count and is as follows:

[1] The following findings of fact as well as those contained elsewhere in this opinion are supported by a preponderance of the evidence.

A data processing method comprising:

inputting recognition data from a speech recognition engine and corresponding audio data, said recognition data including a string of recognised words and audio identifiers identifying audio components corresponding to each of the recognised words;

inputting the recognised words to a processor implementing an interface application program to receive the input recognised words, to pass the recognised words to a processing application program for processing the recognised words to cause the recognised words to be moved, and to form link data linking the audio data to the recognised words, said link data comprising the audio identifiers and information identifying the corresponding recognised words;

displaying the recognised words input to and processed by the processor application program;

selectively identifying a word in the displayed words;

using the interface application program to compare the identity of the selected word with said link data to identify any corresponding audio component; and

playing back any identified corresponding audio component.

8. The claims of the parties are:

Mitchell:	1-78
Holt:	51-57, 59-62, 68-76, 78 and 80-94

9. The claims of the parties which correspond to the count are:

Mitchell:	1-5, 7, 9, 14-16, 18, 21, 22, 24, 25, 27-31, 33, 35, 36, 40, 41, 43, 48, 50, 51, and 60-78

Holt: 51-57, 59-62, 68-76, 78 and 80-94

10. The claims of the parties which do not correspond to Count 1, and therefore are not involved in the interference, are:

Mitchell: 6, 8, 10-13, 17, 19, 20, 23, 26, 32, 34, 37-39, 42, 44-47, 49, and 52-59

Holt: none

11. Holt's involved application was filed on July 12, 1999 and is a continuation of application 08/556,077, filed 13 November 1995, now patent 5,960,447 ('447), issued 28 September 1999. (Ex. 2002).

12. The specification of the '447 patent is identical to the specification of Holt's involved application filed on July 12, 1999.

13. Holt first presented claims 51-94, copied from Mitchell's involved patent, in a preliminary amendment filed on July 12, 1999.[2]

14. Claims 51-94 were copied from Mitchell's involved patent. (Paper 97 at B-4; Mitchell's MF18; admitted by Holt).

15. Holt's involved claims remain similar, or identical to, Mitchell's claims.

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[2] Holt did not submit a new oath with its preliminary amendment filed on the same day as its involved application. Rather, Holt filed a copy of the oath submitted in the Holt parent application. (Application 09/351,542; Oath, filed July 12, 1999). By operation of rule, when an applicant submits copies of the oath and the specification from a prior application as parts of a continuation application, the continuation must not contain any new matter relative to the specification of the prior application. 37 CFR 1.63(d)(1)(iii). Therefore, the January 12, 1999 preliminary amendment is not part of the original disclosure and Holt does not assert otherwise.

16. For example, with the exception of how the parties spell the word "recognized", Holt independent claims 82, 87 and 93 are identical to Mitchell claims 64, 69 and 75 respectively, while Holt independent claims 51 and 60 are similar to Mitchell independent claims 1 and 15 respectively.

One of ordinary skill in the art

17. Notwithstanding the parties' submissions, we find that the level of skill in the art is defined by the prior art of record.

Mitchell Motion 7

18. Mitchell seeks to exclude Porter's testimony on the basis that it is unreliable.

19. Porter's Curriculum Vitae, under the subtitle "Publicity" lists "Fortune Magazine 'Top 25 Cool Companies' July 7, 1997." (Ex. 1001; "Fortune").

20. In the Fortune article, reference is made to a Todd Porter that worked as an exotic dancer ("Preacher Boy") to pay his way through seminary in Iowa. (Ex. 2091 at 5).

21. Mitchell cross examined Porter about the statement and Porter denied that he had ever worked as an exotic dancer, further implying that the reference in the article had been a joke. (Ex. 1056 at 165:11 to 167:7).

22. However, in an unrelated case, *Wright v. Ion Storm L.P., et al.* (Civil Action DV 98-0408, "*Ion Storm*"), Porter testified that he had worked as an exotic dancer under the stage name Preacher Boy. (Ex. 2105 at 62:7 to 63:6).

23. Mitchell cross examined Porter regarding his deposition

testimony in the *Ion Storm* case and Porter admitted that he had testified falsely under oath that he had worked as an exotic dancer, but then later stated that he corrected his testimony because his testimony was not true. (Ex. 1094 at 50:5 to 52:17).

24. The court reporter's certification of Porter's *Ion Storm* deposition transcript indicates that the transcript was delivered to Porter's attorney in the *Ion Storm* case and that the deposition transcript was not returned to the deposition officer by Porter. (Ex. 2106).

25. We find that since the deposition transcript was not returned, that no corrections were actually made and that Mr. Porter did not make corrections contrary to his assertions that he did.

Mitchell Motion 2

26. Mitchell argues that Holt's involved claims fall into three groups; (1) Group 1 contains 51-57, 59-62, 68-76, 78, 80-81 and 93-94; (2) Group 2 contains claims 82-86; and (3) Group 3 contains claims 87-92.

27. Group 1 claims are either in means-plus-function format or method claims.

28. Claims 51 and 68 are representative and are reproduced below (disputed terms highlighted):

51. Data processing apparatus comprising:

> input means for receiving recognition data from a speech recognition engine and corresponding audio data, said recognition data including a string of recognized words and audio identifiers identifying audio components corresponding to each recognized word;

storage means for storing said audio data received from said input means;

interface application program means

for receiving the input recognized words,

for placing the recognized words into positions in a processing application program means to allow processing of the recognized words to change the positions of the recognized words to form a processed word string,

for determining the positions of the recognized words in said processing application program means,

for monitoring changes in the positions of the recognized words, and

for forming link data linking the audio data to the recognized words, said link data comprising the audio identifiers and the determined positions of corresponding recognized words,

for updating said link data in response to monitored changes in positions of the recognized words;

display means for displaying the recognized words received and processed by said processing application program means;

user operable selection means for selecting at least one word in the displayed words, said interface application program means identifying any audio components, when present, which are linked to the at least one selected word; and

audio playback means for playing back any identified audio components in the order of the word positions in the word string or the processed word string.

68. A data processing method comprising:

receiving recognition data from a speech recognition engine and corresponding audio data in an interface application program, said recognition data including a string of recognized words and audio identifiers identifying audio components corresponding to each recognized word;

storing the audio data;

inputting the recognized words into a processing application program which places the words in positions in the application, and which processes the recognized words such that positions of the recognized words are changed to form a processed word string;

using the interface application program to determine the positions of the recognized words in the processing application program, monitor changes in the positions of the recognized words, and to form link data linking the audio data to the recognized words, said link data comprising the audio identifiers and the determined positions of corresponding recognized words, said link data being updated in response to monitored changes in positions of the recognized words;

displaying the recognized words input to and processed by the processor application;

selecting at least one displayed word, whereby said link data identifies any audio components, if present, which are linked to the at least one selected word; and

playing back any selected audio components in the order of the word positions in the word string.

29. According to Mitchell Motion 2, Holt does not have written

description support for an interface application (or second application) that functions to: (1) determine the positions of the recognized words in the processing application program; (2) form link data which includes the determined positions of the recognized words; (3) monitor changes in the positions of the recognized words; or (4) update link data in response to monitored changes. (Paper 73 at 5:23 to 6:3).

30. In support of its Motion 2, Mitchell relies on the testimony of Richard L. Sonnier III ("Sonnier").

31. Sonnier is the president and founder of Nimble Services, Inc. a company that provides information technology services to clients and has substantial experience in the relevant art since at least the time of the inventions. (Ex. 2005, ¶¶ 2-3).

32. We find that Sonnier has sufficient qualifications to testify about the relevant state of the art at the time of the invention.

33. Sonnier testifies that Holt's specification generally describes Embedded Tagging Embodiments and a Mirrored Embodiment. (Ex. 2005).

The Embedded Tagging Embodiments

34. Holt Figure 2 is reproduced below:

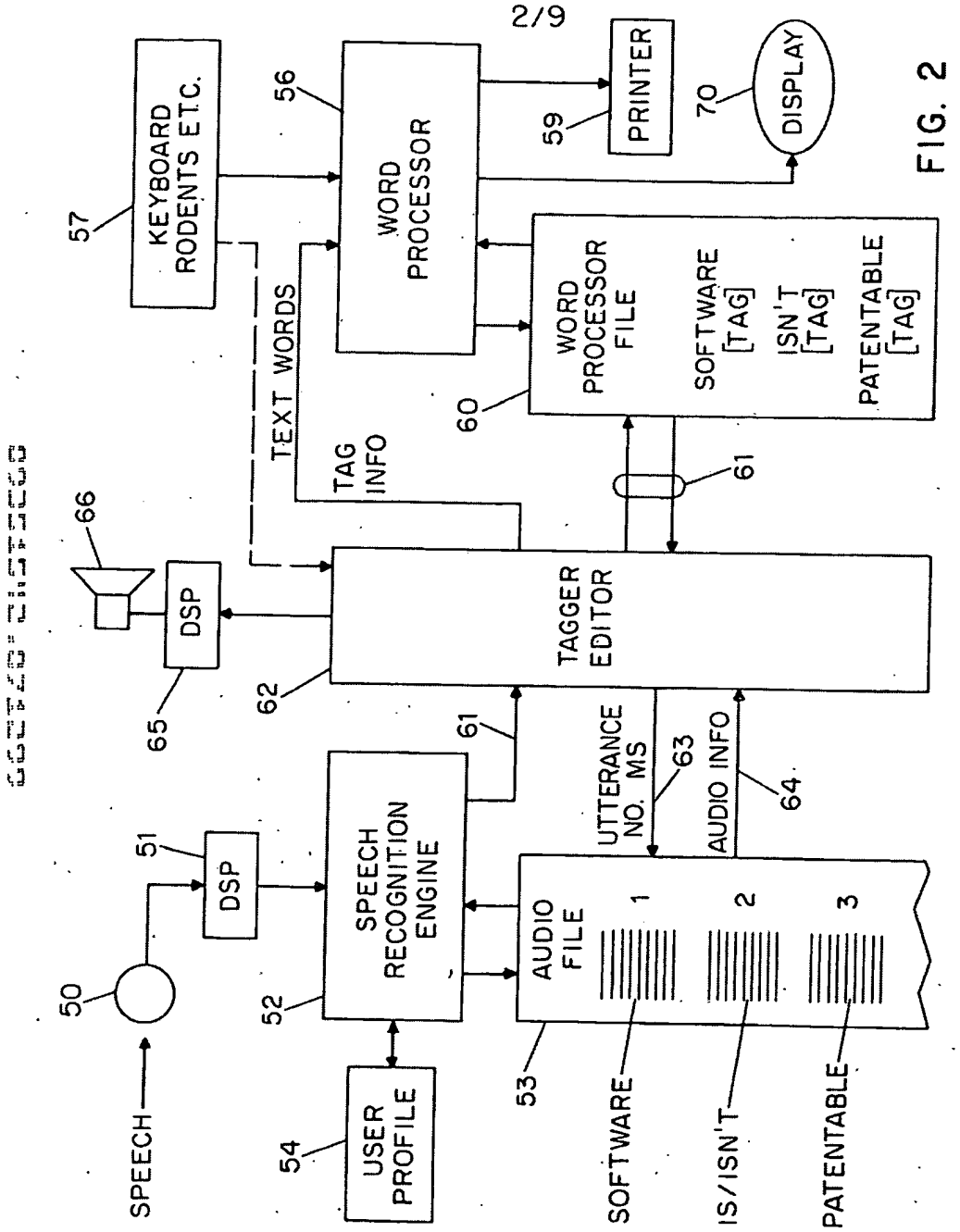

FIG. 2

35. Holt's specification describes embedded tagging arrangements where a tagger editor 62 receives word text and related information from the speech recognition engine 52 (Ex. 2003 at 8:8-9).

36. The word text and related information represents a cluster of data or information which needs to be linked in "some manner" with the word/text/data as it is put into an external application. (Ex. 2003 at 8:9-11).

37. The word processor file 60, not the tagger editor, contains and stores the text words and tag information. (Ex. 2003 at 8:13-15; 8:18).

38. The tag information that is stored by the word processor file 60 follows the text if it is cut or copied or pasted using standard editing features of the word processor application. (Ex. 2003 at 8:18-19 to 9:1-2).

39. A user can select on a text in the word processor application and the system finds the sound bite in the audio file 53 and replays the sound. (Ex. 2003 at 9:2-4).

40. In connection with the description of the tagger editor 62, there is no description that the tagger editor determines the positions of recognized words in the word processor application program.

41. The Holt specification describes that in the case of Microsoft Word®, tag information is stored by way of a bookmark and the bookmark stores the tag in its name. (Ex. 2003 at 14:3-4).

42. The bookmark is described as going with the text that is cut or copied and pasted into a new location within the same or another document. (Ex. 2003 at 12:9-12).

43. The Holt specification explains that this method, using the Microsoft Word® and its bookmark capability, allows the word tag information to be associated with the text even when it is placed into a clipboard or moved around. (Ex. 2003 12:14-19 to 13:2).

44. Sonnier explains that for the embedded tagging embodiments, the interface application would be the tagger editor shown as element 62 in Figure 2 of Holt's application. (Ex. 2005, ¶ 31).

45. Sonnier further explains that while the tagger editor 62 sends recognized words and their embedded tags to the word processor 56, the tagger editor does not store the recognized words and the tags because the word processor 56 maintains the association between the recognized words and their embedded tags whenever the words are moved. (Ex. 2005 ¶¶ 31-37).

46. For this reason, the tagger editor has no need to monitor for changes in the recognized words or update link data in response to such changes. (Id.).

47. Holt's specification describes another tagging arrangement using OLE (object linking and embedding). (Ex. 2003 at 18).

48. Sonnier explains that OLE is a mechanism where a first application may embed its data or document in a second application's data or document and that Holt's specification describes the use of OLE as another form of embedding tag information into a text word of a word processor application. (Ex. 2005, ¶ 24).

49. The Holt Application describes the word tags can be used with embedded OLE objects. (Ex. 2003 at 18:9-10).

50. However, there is no description that the use of OLE objects changes the way the tagger editor would function in connection with a processor application that uses the OLE objects.

51. Sonnier expresses as much by explaining that one of ordinary skill in the art would understand from reading the Holt application that the word processor must maintain the association between the OLE tags and the recognized words and that the tagger editor 62 does not. (Ex. 2005 at ¶¶ 24-25).

The Mirrored Embodiment

52. Holt's specification describes the following (emphasis added):

> Yet another embodiment of the invention is termed a "mirrored" approach. With this approach the mirrored application running in the background completely duplicates every edit and every change implemented in the host application (the word processor). *The need for this is strictly for applications that could not or do not support bookmarks, third party codes, hidden text, and embedded OLE objects or any other means of tagging, and still need to provide the benefits of the invention.* This approach requires that everything occurring in the host application be duplicated, including window size, scroll, etc. This utilizes a background window 67, shown in Fig. 3, that mirrors the focused application 56. This requires, of course, that the designer of the mirror application 62 know where the fields are in the host application that are to be set up with tags to correspond to recognized words. It is necessary to track every change made to the foreground (host application) window (screen 70, representing word processor file 58) in the background window 67 (in the mirrored application). Such an approach has numerous drawbacks, of course, not the least is system overhead. (Ex. 2003 at 19:12 to 20:5).

53. Figure 3 of the Holt specification is shown below:

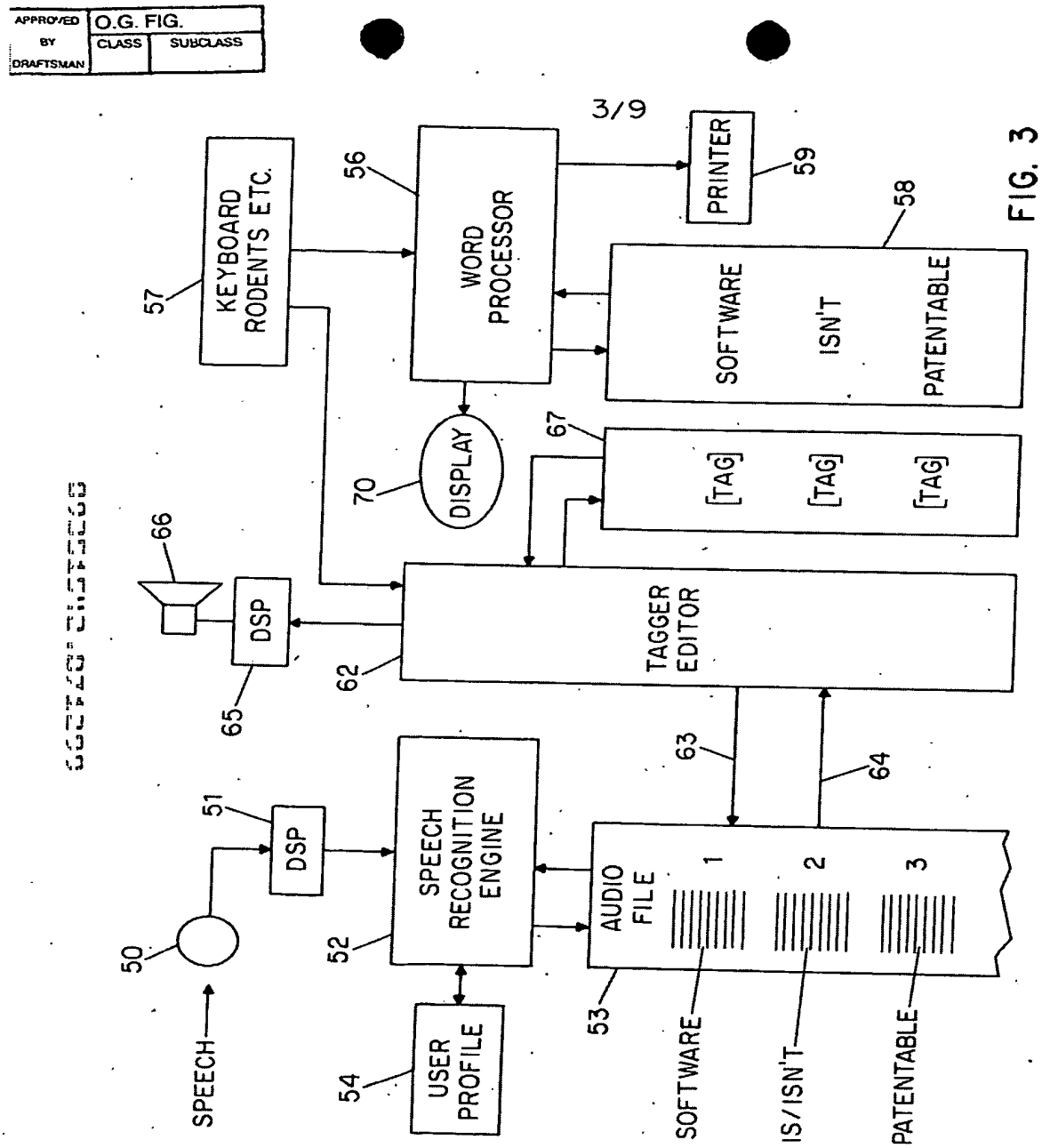

FIG. 3

54. According to Sonnier, the Mirrored Embodiment is a different and distinct embodiment from the Embedded Tagging Embodiments.

(Ex. 2005 ¶ 29).

55. Specifically, one of ordinary skill in the art reading the Holt specification would not conclude that features of the tagging embodiments could be combined with features of the mirrored embodiments. (Ex. 2005 at ¶ 34).

56. The Holt specification is consistent with Sonnier' s testimony since it describes that the mirrored approach "is strictly for applications that could not or do not support bookmarks, third party codes, hidden text, and embedded OLE objects or any other means of tagging, and still need to provide the benefits of the invention." (Ex. 2003 at 19:14-17).

57. One of ordinary skill in the art reading the above passage would understand that the mirrored approach is an alternative to the "other means of tagging" and not a further explanation or description of the tagging embodiments.

58. Sonnier explains that a skilled artisan reviewing the Holt specification would conclude that the Mirrored Embodiment utilizes a hidden window 67 for the purpose of replicating changes made in the word processor display 70 by duplicating everything occurring in the host application including window size changes, window scrolling, etc. (¶ 9).

59. Sonnier further explains that the mirrored application 62 attempts to run a duplicate (or second instance) of word processor 56 in hidden window 67, but the Holt specification fails to explain how a second instance of the word processor would be able to embed tags. (¶ 10.)

60. According to Sonnier, the mirrored application 62 would have no means to determine the text-position of a recognized word selected by a user in the word processor. (¶¶ 12-13).

61. According to Sonnier, that is so because a skilled artisan would understand that the Holt Application describes using screen positions of the recognized words and not the text-positions of the words. (¶¶ 16-17).

62. Sonnier testifies that a skilled artisan would understand that the Holt specification does not describe that the mirrored application 62 obtains or determines the positions of the recognized words. (¶ 18).

63. Sonnier explains that in order for the mirrored application 62 to determine the positions of recognized words, the mirrored application would have to communicate with the word processor 56, which it does not. (Id.).

64. Sonnier further testifies that the Mirrored Embodiment (shown in Fig. 3 of the Holt specification) includes a mirrored application 62 (e.g., the interface or second application); however, the mirrored application 62 does not input recognized words into a word processor or communicate with the word processor. (Ex. 2005, ¶ 32).

65. As such, the mirrored application 62 has no means by which to determine the positions of the recognized words in the word processor document as claimed in the Group 1 claims. (Id. ¶ 35).

66. Sonnier testifies that even if the mirrored application 62 does somehow communicate with the word processor 56, the Holt application still does not describe or suggest that the Mirrored Embodiment forms link data that includes the text position of the recognized words, or monitors for changes in those positions, or updates link data based on monitored changes. (Id.).

67. The Holt specification describes that the Mirrored Embodiment

requires that the designer of the mirror application 62 know where the fields are in the host application that are to be set up with tags to correspond to recognized words. (Ex. 2003 at 19:19 to 20:2).

68. Sonnier explains that that description of "fields" refers to the use of predefined forms as shown in Figure 5. (Ex. 2005, ¶ 19).

69. The fields are described in the specification as predefined areas of a screen or display (pixel rectangles). (Id.; Ex. 2003 at 22:19 to 23:5).

70. As such, the fields are predetermined and not determined by the mirror application. (Ex. 2005, ¶ 19).

C. Analysis

The parties have filed several motions for consideration. For each motion, the respective party has the burden of proof to establish that it is entitled to the requested relief. Bd.R. 121(b). The burden of proof is by a preponderance of the evidence. The burden of showing something by a preponderance of the evidence simply requires the trier of fact to believe that the existence of a fact is more probable than its nonexistence before the trier of fact may find in favor of the party who carries the burden. *Concrete Pipe & Products of California, Inc. v. Construction Laborers Pension Trust for Southern California*, 508 U.S. 602, 622 *1993).

The Board may take up motions for decisions in any order. Bd.R. 125(a). We begin our analysis with Mitchell Motion 7.

Mitchell Motion 7

In its Motion 7, Mitchell moves to exclude the testimony of Holt's expert, Todd Porter. Holt relies on Mr. Porter's testimony in support of several of its

motions and several of its oppositions. Mr. Porter's testimony is crucial for Holt. As counsel for Holt stated during oral argument, Mitchell Motion 7 is "potentially outcome-determinative, which is very unusual for a motion to exclude." (Paper 346 at 16:15-18). Therefore, we consider this motion prior to all other motions.

Mitchell moves to exclude Porter's testimony on the basis that his testimony is unreliable and because Porter is not qualified as an expert. (Paper 137 at 1:3-5; Mitchel Motion 7).

Mitchell argues that Porter's testimony is not trustworthy because he testified falsely under oath and admitted as such. (Paper 137 at 3:9-10). The issue arose as follows. In support of Porter's declarations, Holt served Porter's Curriculum Vitae (CV). Porter's CV, under the subtitle "Publicity" lists "Fortune Magazine 'Top 25 Cool Companies' July 7, 1997." (Ex. 1001; "Fortune"). In the Fortune article, reference is made to a Todd Porter that worked as an exotic dancer to pay his way through seminary in Iowa. (Ex. 2091 at 5). Counsel for Mitchell cross examined Porter about the Fortune article and Porter denied that he had ever worked as an exotic dancer. (Ex. 1056 at 165:11 to 167:7).

Mitchell discovered that Porter had testified about his past work experiences, e.g., being an exotic dance, in an unrelated case, *Wright v. Ion Storm L.P., et al.* (Civil Action DV 98-0408, "*Ion Storm*"; Ex. 2105, Oral Deposition of Todd Mitchell Porter, Vol. 1, Nov. 4, 1998). There, Porter testified that he had worked as an exotic dancer under the stage name Preacher Boy. (Ex. 2105 at 62:7 to 63:6). Counsel for Mitchell again cross examined Porter, this time regarding his deposition testimony in the *Ion*

Storm case. During cross examination, Porter maintained that he had never worked as an exotic dancer. Instead, Porter admitted that he had testified falsely under oath in the *Ion Storm* case that he had worked as an exotic dancer. (Ex. 1094 at 50:5 to 51:16). Porter indicated that he testified that way following the lead of the group. ("I know, and I made the mistake of saying-following the lead of our – at that point of our rest of the group." Ex. 1094 at 51:17 to 52:4). Porter also explained that he had corrected his testimony because his testimony was not true. (Ex. 1094 at 51:17 to 52:4). However, there is no evidence of record that demonstrates that corrections were ever made to the deposition transcript. Instead, the court reporter's certification of Porter's *Ion Storm* deposition transcript indicates that the transcript was delivered to Porter's attorney in the *Ion Storm* case and that the deposition transcript was not returned to the deposition officer by Porter, e.g., that no corrections were made. (Ex. 2106).

In its opposition 7, Holt does not deny any of the above. (Paper 146; Mitchell MFs 36-43; admitted). Holt's response is that the argument is a sideshow and that Porter's false testimony in the *Ion Storm* case and the false statements Porter made in this case about his prior work experience has nothing to do with Porter's qualifications as an expert concerning the technology involved in the case or the accuracy of his testimony concerning the technology. (Paper 146 at 1). We disagree.

The Federal Rules of Evidence applies in interference proceedings. Bd. R. 152(a). Federal Rule of Evidence 702, entitled "Testimony by Expert Witnesses" states:

> A witness who is qualified as an expert by knowledge, skill, experience, training, or education may testify in the form of an opinion or otherwise if:
>
> **(a)** the expert's scientific, technical, or other specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in issue;
>
> **(b)** the testimony is based on sufficient facts or data;
>
> **(c)** the testimony is the product of reliable principles and methods; and
>
> **(d)** the expert has reliably applied the principles and methods to the facts of the case.

Expert evidence must be reliable. Fed. R. Evid. 702. Holt would want us to ignore that Mr. Porter lied while under oath in both this case and in an unrelated case, since the lies pertained to a past indiscretion. We agree that whether Mr. Porter was an exotic dancer is not germane to the issues before us. We agree that whether Mr. Porter corrected his testimony made during the *Ion Storm* case about being an exotic dancer is not germane to the issues before us. Mr. Porter's lying about both instances does go to the accuracy of Porter's testimony in this case. Telling a lie while under oath is a big deal, no matter what a witness is lying about. A person submitting testimony swears under oath that the statements they make are true, subject to penalties of perjury. In a situation like the one before us, where a witness has lied while under oath and admits as much, the veracity of the witness is questionable. The trier of fact in cases such as this one often relies on the testimony of witnesses to tell the trier of fact about the technology and about

the knowledge that a person skilled in the relevant art would have had at the time the invention was made. Such testimony must be reliable.

Mr. Porter explained that he lied under oath in the *Ion Storm* case because he was following the lead of the group. (Ex. 1094 at 51:14-21). His testimony leads us to believe that he was persuaded by outside influences to lie; he followed the will of others instead of testifying honestly. Here, Porter has been paid $275 per hour plus expenses to testify as to certain facts, based on his expertise. (Ex. 1006, ¶ 9). In this proceeding, where the potential for monetary gain for telling a lie can be substantial, for example, being paid a substantial amount of money to testify that Holt does have written description support for certain claimed terms, we are not confident that Porter's testimony is reliable or trustworthy. Moreover, it is equally troubling that Mr. Porter lied during this proceeding about making corrections to his *Ion Storm* deposition. There is no evidence of record to support Mr. Porter's assertion that he later corrected his testimony by making corrections to the court transcript. In fact, the record evidence supports the opposite; that no corrections were made. Based on the facts established by the evidence before us, we do not trust Mr. Porter's testimony.

Mitchell also seeks to exclude Porter's testimony on the basis that Porter is not qualified to testify as an expert by his own admissions. Mitchell argues that Porter defined the knowledge that a person of ordinary skill in the art would possess (the skill set), but then testified on cross examination that he did not possess such knowledge, directing attention to

the following (Ex. 1082 at 333:1-8):

> Mr. Perque: And so to the extent you're opining that it would be a trivial exercise to implement OLE objects as embedded tags, that's just based on sheer speculation; is it not?
>
> Mr. Porter: Well, again, I think that, you know, if – if you look at the person of the skill set that we defined, there are skill sets that person has that I don't even have.

Mitchell argues that based on the above admission, the Board should not consider Porter's testimony because he is not an expert and fails to meet the admissibility standard under Fed. R. Evid. 702, citing to *Sundance, Inc. V. Demonte Fabricating Ltd.* 550 F3d 1356, 1362 (Fed. Circ. 2009) ("[w]here an issue calls for consideration of evidence from the perspective of one of ordinary skill in the art, it is contradictory to Rule 702 to allow a witness to testify on the issue who is not qualified as a technical expert in that art."). (Paper 137 at 6). Mitchell also directs attention to *Centricut, LLC v. The Esab Group, Inc.*, 390 F3d 1361, 1368 (Fed. Cir. 2004), where a party attempted to present expert testimony from an inventor who admitted that he was not an expert in the art at issue and as a result, the court held he "offered no foundation for offering reliable testimony."

Mitchell's argument is persuasive and Holt has not persuaded us otherwise. Indeed, Holt does not address or provide an explanation regarding Porter's admission. Based on the above testimony, it appears to us that Mr. Porter does not believe himself to have the qualifications or skills that a person of ordinary skill in this art would have. As a consequence, his averments as to what a person of ordinary skill in the art at the time of the

invention understands with respect to the involved technology and the claimed invention would appear to be unfounded. Mr. Porter admitted that he does not have the skills or knowledge that a person of ordinary skill in the art would have, and for this additional reason, we find that he is not qualified to testify as an expert in the field with respect to what a person of ordinary skill in the art would have known at the time of the invention.

Mitchell makes additional arguments as to why Porter is not qualified as an expert. (Paper 137 at 7). Mitchell focuses on all of the skills Porter lacks, such as his lack of formal training in computer programming and his lack of familiarity with speech recognition systems in general and with specific computer programs. Holt opposes and explains why Mr. Porter is qualified to testify. (Paper 146 at 2-3). We have considered Holt's arguments in that regard but do not find that such arguments overcome our determination that Porter is not qualified to testify as an expert based on his admission.

Mr. Porter lied in the past and lied in this proceeding. On that basis, he is not a reliable witness and we exclude his testimony. Mr. Porter also admitted that he does not have the skill set for even a person with ordinary skill in the art. On that basis, he does not qualify as an expert and we exclude his testimony. In sum, Mr. Porter is not reliable and he does not have the requisite skill set and so he does not qualify as an expert witness. Therefore, we GRANT Mitchell's request to exclude Todd Porter's testimony in its entirety.

Mitchell argues that Todd Porter's third declaration, e.g., Ex. 1059

should be excluded for additional reasons. (Paper 137 at 8-11). We need not and do not consider those arguments, since we exclude Todd Porter's testimony, including his third declaration, in its entirety.

Mitchell further seeks to exclude several of Holt's exhibits that Holt relied on in support of Holt Motion 2. (Paper 137 at 12). As explained below, we grant Mitchell's Motion 2 for judgment against Holt on the basis that all of Holt's involved claims 51-57, 59-62, 68-76, 78 and 80-94 are unpatentable under 35 U.S.C. § 112, ¶ 1 based on the written description requirement. The granting of Mitchell Motion 2 deprives Holt standing to continue in this interference. Moreover, Holt Responsive Motion 6 to add to the interference a Holt claim is denied. Accordingly, the remaining motions are dismissed.

Since we dismiss Holt Motion 2, there is no occasion to consider the exhibits in connection with that motion. Therefore, Mitchell Motion 7 in that regard is dismissed. For all of the above reasons, Mitchell Motion 7 is GRANTED-IN-PART and DISMISSED-IN-PART.

Mitchell Motion 2

In its Motion 2, Mitchell moves for judgment against Holt on the basis that all of Holt's involved claims 51-57, 59-62, 68-76, 78 and 80-94 are unpatentable under 35 U.S.C. § 112, ¶ 1 based on the written description requirement (Paper 73). Mitchell does not argue that any of Holt's dependent claims are separately unpatentable based on the written description requirement. Rather, Mitchell's arguments are directed to elements in Holt's independent claims. Holt's dependent claims stand or fall with the independent claims.

"While it is legitimate to amend claims or add claims to a patent application purposefully to encompass devices or processes of others, there must be support for such amendments or additions in the originally filed application." *PIN/NIP Inc. v. Platte Chemical Co.*, 304 F.3d 1235, 1247 (Fed. Cir. 2002)(citing *Kingsdown Med. Consultants, Ltd. v. Hollister Inc.*, 863 F.2d 867, 874 (Fed. Cir. 1988)).

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of filing of the claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, (Fed. Cir. 1991); *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983). One shows that one is "in possession" of the invention by describing the invention, with all its claimed limitations, not that which makes it obvious. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997); *In re Wertheim*, 541 F.2d 257, 262 (CCPA 1976).

Holt claims 51-57, 59-62, 68-76, 78 and 80-94 were initially copied from Mitchell's involved claims. However, some claims were amended in response to a rejection for lack of written description support. There are several of Holt's involved claims that remain identical to several of Mitchell's claims. For example, Holt independent claims 82, 87 and 93, with the exception of how the parties spell the word "recognized", are identical to Mitchell independent claims 64, 69 and 75 respectively. There are some of Holt's claims that are similar, but not identical, to Mitchell's claims, e.g., Holt claim 51 is similar to Mitchell claim 1.

Mitchell argues that since Holt's claims were copied from Mitchell's claims,

Holt's claims must be construed in light of Mitchell's patent, citing *Agilent Technologies, Inc. v. Affymetrix, Inc.*, 567 F.3d 1366, 1374 (Fed. Cir. 2009). (Paper 73 at 3). Holt disagrees that *Agilent* applies, since (1) *Agilent* is inconsistent with a prior CCPA holding, (2) Holt's involved claims are not identical to Mitchell's claims, and (3) there is no real dispute as to what the claims mean and therefore it does not matter whether Holt's claims are construed in light of Holt's specification or Mitchell's specification. (Paper 97 at 2-3).

Holt's arguments are not persuasive. Our reviewing court has repeatedly instructed us that *Agilent* does apply in situations such as the one before us.[3] In addition, it is inaccurate for Holt to assert that its involved claims are not identical to Mitchell's claims. Notwithstanding the way the parties spell the word "recognized", several of Holt's claims are identical to several of Mitchell's claims. Moreover, those Holt claims that are not identical to any one of Mitchell's claims are very similar to Mitchell's claims (*e.g.*, compare Mitchell claim 1 with Holt claim 51). The non-identical claims began as identical copies of Mitchell's claims prior to any subsequent amendment. In our view, it would not make sense to interpret Holt claims that are identical to Mitchell's claims one way, but interpret Holt claims that are similar to Mitchell's claims another way, especially when most of the terms in the non-identical claims are the same. Lastly, we disagree with Holt that there is no occasion to look to the Mitchell specification to determine the meaning of claim terms. "[W]hen a party challenges written description support for an interference count or the copied claim in an interference, the originating

[3] *Koninklijke Philips Electronics N.V. v. Cardiac Science Operating Co.*, 590 F.3d 1326 (Fed. Cir. 2010) and *Robertson v. Timmermans*, 603 F.3d 1309 (Fed. Cir. 2010).

disclosure provides the meaning of the pertinent claim language." *Agilent Technologies, Inc. v. Affymetrix, Inc.*, 567 F.3d 1366, 1375 (Fed. Cir. 2009). For all of these reasons, Holt's involved claims will be interpreted in light of Mitchell's patent.

Group 1 – Holt claims 51-57, 59-62, 68-76, 78, 80-81 and 93-94

Group 1 independent apparatus claims 51, 60 and 93 require an interface application program means (a second application program) for (1) determining the positions of recognized words in a processing application program means (first application program), (2) monitoring changes in the positions of the recognized words, (3) forming link data linking the audio data to the recognized words, said link data comprising the audio identifiers and the determined positions of corresponding recognized words, and (4) updating the link data in response to monitored changes in positions of the recognized words. Independent method claims 68, 81, and 94, although method claims, are similar.[4]

Mitchell characterizes the Holt Group 1 claims as reciting an interface application (or second application) that: (1) determines the positions of the recognized words in a word processor; (2) forms link data which includes the determined positions of the recognized words; (3) monitors for changes in the positions of the recognized words in the word processor; and (4)

[4] For example, independent method claim 68 requires using the interface application program to (1) determine the positions of the recognized words in a processing application program, (2) monitor changes in the positions of the recognized words, (3) form link data linking the audio data to the recognized words, said link data comprising the audio identifiers and the determined positions of corresponding recognized words, and (4) update the link data in response to monitored changes in positions of the recognized words.

updates link data in response to the monitored changes. (Paper 73 at 5:23 to 6:3). Holt does not express disagreement with this characterization. (Paper 97 at 11:14-20).

Mitchell argues, with supporting evidence, that Holt's specification, as originally filed, does not provide written description support for an interface application (or second application) which determines, forms, monitors and updates as claimed. (Paper 73 at 12:17-20). For the reasons that follow, Mitchell has met its burden of proving, with supporting evidence, that Holt's involved specification, as originally filed, does not provide written description support for Holt claims 51-57, 59-62, 68-76, 78, 80-81 and 93-94, e.g., the Group 1 claims.

Claim interpretation of certain Group 1 terms

Mitchell argues, with supporting evidence, that a skilled artisan would understand that the position of a [recognized] word in a processing application program refers to the text or character position of the word (the word's offset measured by the number of intervening characters from the beginning of the word processor document), and would not include a transient display location (the rectangle of pixels locations). (Paper 73 at 10:12-15; Ex. 2005, ¶¶ 14-15). We credit Sonnier's testimony as to this point, since it is consistent with the Mitchell specification which describes:

> The position of a word in the text in the text processor application 13 is determined by determining the counter number indicating the position of the first character in the text for the word. This character number is entered under the character number field. (col. 7:7-12).

We understand the above to mean that the position of a word in a processor application is determined based on the position of the first character in the text document based on the counter number from the beginning of the document. Thus, the above passage is consistent with Sonnier's testimony that a person of ordinary skill in the art would have understood the determining function to be achieved based on the text position of a word and not based on the display location of the word. Holt does not argue in its opposition that Mitchell's interpretation is incorrect; that the position of a [recognized] word in a processing application program refers to the text or character position of the word and not a transient display location. Rather, Mitchell appears to focus on whether the Mirrored Embodiment does determine the text position of recognized words.

The Group 1 claims also require the interface application functions to determine, monitor, form and update, despite Holt's argument to the contrary. Specifically, Holt argues that the Group 1 claims do not require that the determining positions of the recognized words, monitoring changes in positions of the recognized words, or forming link data linking audio data to the recognized words, function independently of the Target Application. Holt argues that the system can utilize the functionality provided by the Target Application and still fall within the scope of the Holt claims. (Paper 97 at 13:4-8). Holt directs us to Todd Porter's testimony in support of Holt's proposed interpretation.[5] As provided above, Porter's testimony is excluded. Therefore, Holt's argument is unsupported and not persuasive. *See Estee Lauder Inc. v. L'Oreal, S.A.*, 129 F.3d 588, 595

[5] Claim elements must be construed as they would be understood by those skilled in the art. *See, e.g., Hoechst Celanese Corp. v. B.P. Chems., Ltd.*, 78 F.3d 1575, 1578 (Fed. Cir. 1996).

(Fed. Cir. 1997) (Argument of counsel cannot take the place of evidence lacking in the record).

Additionally, Holt's Group 1 claims are clear on their face. The claims require the interface application to determine, monitor, form linking data and update link data. We disagree that the functionality of the interface application can be met by the processing application or that the system can utilize functionality provided by the processing application to meet the claim limitation. Also, where a claim provides for two separate elements, those two elements cannot be one and the same. *Gaus v. Conair Corp.*, 363 F.3d 1284, 1288 (Fed.Cir. 2004). *See also Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1562 (Fed. Cir. 1991)(there can be no literal infringement where the patent in suit claims two elements and the accused device has only one element performing both functions). Our interpretation is consistent with the Mitchell specification, which describes that the interface application functions to determine, monitor, form, etc. and that those functions are not accomplished by the processing or target application. (See, e.g., Ex. 1003 at col. 9:29-32; col. 10:18-20 and col. 8:65 to col. 9:1).

Mitchell appears to interpret the phrase "for determining the positions of the recognized words in said processing application program [means]" as recited in Holt claim 51, for example, to mean determining the positions of recognized words that have already been inserted into the processing application (Paper 73 at 12:17-20). Holt appears to interpret the same phrase to cover determining positions of recognized words before they have been inserted into the processing application as well as after they have been inserted into the processing application. (Paper 97 at 12:10-11 and 12:12-13). Thus, Holt's proposed interpretation is broader. Reading

the totality of representative Holt claim 51, we agree with Mitchell that the determining function is with respect to determining the positions of recognized words that have already been inserted into the processing application. For example, claim 51 recites "interface application program means ... for placing the recognized words into positions in a processing application program means to allow processing of the recognized words to change the positions of the recognized words to form a processed word string ... for determining the positions of the recognized words in said processing application program means." The plain meaning of this phrase indicates that the determining is performed on the words already in place in the processing application program means.

This interpretation is consistent with the Mitchell specification which describes the interface application program determining the positions of the recognized words already inserted in the processing application program. (See, e.g., Ex. 1003 at col. 9:29-32; col. 10:18-20). Holt has not presented reliable evidence to the contrary.

Mitchell sufficiently shows that Holt Group 1 claims lack support

At the start, we note that Holt's specification does not explicitly describe that an interface application program, such as the tagger editor 62, determines, monitors, forms or updates as claimed. However, it is not necessary for an applicant to provide *ipsis verbis* support for claim terms. The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of filing of the claimed subject matter.

determines and monitors

Mitchell sufficiently demonstrates that the Holt specification does not explicitly, implicitly or inherently describe an interface application that determines or monitors as claimed. Mitchell argues that there are generally two embodiments described in Holt's specification; the embedded tagging embodiments and the mirrored embodiment. (Paper 73 at 6:15-16). Mitchell relies on Sonnier's testimony to explain the general embodiments described in the Holt specification.

Sonnier sufficiently explains why the embedded tagging embodiments do not implicitly, explicitly, or inherently describe an interface application for determining or monitoring. Sonnier explains that for the embedded tagging embodiments, the interface application would be, for example, the tagger editor shown as element 62 in Figure 2 of Holt's application. (Ex. 2005, ¶ 31). Sonnier further explains that while the tagger editor 62 sends recognized words and their embedded tags to the word processor 56, the tagger editor does not store the recognized words and the tags because the word processor 56 maintains the association between the recognized words and their embedded tags whenever the words are moved. (Ex. 2005 ¶¶ 31, 35). We credit Sonnier's testimony because it is consistent with Holt's specification.

Holt's specification describes embedded tagging arrangements where a tagger editor 62 receives word text and related information from the speech recognition engine 52 (Ex. 2003 at 8:8-9). The word text and related information represents a cluster of data or information which needs to be linked in "some manner" with the word/text/data as it is put into an external application. (Ex. 2003 at 8:9-11).

The word processor file 60, not the tagger editor, contains and stores the text words and tag information. (Ex. 2003 at 8:13-15; 8:18). The tag information that is stored by the word processor file 60 follows the text if it is cut or copied or pasted using standard editing features of the word processor application. (Ex. 2003 at 8:18-19 to 9:1-2). A user can select on a text in the word processor application and the system finds the sound bite in the audio file 53 and replays the sound. (Ex. 2003 at 9:2-4).

With respect to the description of the tagger editor 62, there is no description that the tagger editor performs the function of determining the positions of recognized words in the word processor application program or that it performs the function of monitoring changes in the positions of recognized words. There is not much described about the tagger editor 62 at all. Instead, the Holt specification is much more focused on the word processor and how the word processor maintains the tag information. For example, in the case of Microsoft Word®, the tag information is stored by way of a bookmark and the bookmark stores the tag in its name. (Ex. 2003 at 14:3-4). The bookmark is described as going with the text that is cut or copied and pasted into a new location within the same or another document. (Ex. 2003 at 12:9-12). The Holt specification explains that this method, using the Microsoft Word® and its bookmark capability, allows the word tag information to be associated with the text even when it is placed into a clipboard or moved around. (Ex. 2003 12:14-19 to 13:2).

The description in Holt's specification is consistent with Sonnier's explanation that a skilled artisan reading the Holt specification would understand that while the tagger editor 62 sends recognized words and their embedded tags to

the word processor 56, the tagger editor does not determine (and store) the positions of the recognized words and the tags because the word processor file 60 and word processor 56 maintains the association between the recognized words and their embedded tags whenever the words are moved. (Ex. 2005 ¶¶ 31-37). Mitchell has sufficiently demonstrated that the tagger editor 62 (interface application or second application) does not determine the positions of the recognized words in the word processor. As explained, it has no reason to and the Holt specification does not describe otherwise. For similar reasons, Mitchell has sufficiently demonstrated that the tagger editor does not monitor for changes in the positions of the recognized words, since as already explained it is the word processor that keeps track of or monitors when a word changes positions.

Mitchell has also sufficiently demonstrated that the tagger embodiment describing the use of OLE (object linking and embedding) does not describe an interface application that determines the positions of recognized words in the word processor or monitors for changes as claimed. Sonnier's testimony is consistent with the Holt application that the use of OLE objects is another form of embedding tag information into a text word of a word processor application. (Ex. 2005 at ¶ 24). Specifically, the Holt application describes that the word tags can be used with embedded OLE objects. However, there is no description that the use of OLE objects changes the way the tagger editor would function in connection with a processor application that uses the OLE objects. And Sonnier expresses as much by explaining that one of ordinary skill in the art would understand from reading the Holt application that the word processor must maintain the association between the OLE tags and the recognized words and that the tagger editor 62 does not.

(Ex. 2005 at ¶¶ 24-25). Thus, Mitchell has sufficiently demonstrated that the OLE tagging embodiment does not describe an interface application (second application) that determines or monitors as claimed.

Holt does not argue that the tagging embodiments describe an interface application that performs all of the functions as claimed. Rather Holt argues that between the described interface application and the described target application all of the functions are performed. In other words, Holt argues that the Group 1 claims do not require that the interface application determines the recognized words or monitors changes in positions of the recognized words independently of the target application. Holt argues that the system can utilize the functionality provided by the target application and still fall within the scope of the Holt claims. (Paper 97 at 13). We disagree and have addressed this argument above in the claim construction section of the Group 1 claims.

As explained above, Holt's Group 1 claims are clear on their face. The claims require an interface application for determining and monitoring. We disagree that the functionality of the interface application can be met by the processing application or that the system can utilize functionality provided by the processing application to meet the claim limitation. Our interpretation is also consistent with the Mitchell specification as already explained, which describes that it is the interface application that functions to determine and monitor and not the processing application.

Therefore, Holt's arguments that its embodiments (a), (b)[6], (d), (e), and (f) that each use functionality provided by the target application (the word processor)

[6] At page 13, line 9, we understand Holt to mean "(b)" and not "(c)" since (c) is

to determine positions of recognized words and to monitor changes, even if true, is not persuasive, since the showing is based on an incorrect interpretation of the Holt claims.

Mitchell has also sufficiently demonstrated that the Mirrored Embodiment described in the Holt application does not describe an interface application that determines the recognized words in a word processing program or monitors the changes in the positions of recognized words. The Mirrored Embodiment description is brief and is as follows:

> Yet another embodiment of the invention is termed a "mirrored" approach. With this approach the mirrored application running in the background completely duplicates every edit and every change implemented in the host application (the word processor). The need for this is strictly for applications that could not or do not support bookmarks, third party codes, hidden text, and embedded OLE objects or any other means of tagging, and still need to provide the benefits of the invention. This approach requires that everything occurring in the host application be duplicated, including window size, scroll, etc. This utilizes a background window 67, shown in Fig. 3, that mirrors the focused application 56. This requires, of course, that the designer of the mirror application 62 know where the fields are in the host application that are to be set up with tags to correspond to recognized words. It is necessary to track every change made to the foreground (host application) window (screen 70, representing word processor file 58) in the background window 67 (in the mirrored application). Such an approach has numerous drawbacks, of course, not the least is system overhead. (Ex. 2003 at 19:12 to 20:5).

As seen from above, the mirrored approach "is strictly for applications that could not or do not support bookmarks, third party codes, hidden text, and

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characterized on page 12 of Holt's opposition as the mirrored embodiment.

embedded OLE objects or any other means of tagging, and still need to provide the benefits of the invention." (Ex. 2003 at 19:14-17). Sonnier explains that the mirrored embodiment is a different and distinct embodiment from the described embedded tagging embodiments and that one of ordinary skill in the art reading the Holt specification would not conclude that features of the described tagging embodiments could be combined with features of the mirrored embodiments. (Ex. 2005 at ¶¶ 29 and 34). We credit Sonnier's testimony since it is consistent with the paragraph above which one of ordinary skill in the art would understand to mean that the mirrored approach is a different and distinct embodiment to the "other means of tagging" described in the Holt specification and not a further explanation or description of those tagging embodiments.

The Holt specification further describes that the mirrored approach requires that everything occurring in the host application (word processor) be duplicated, including window size, scroll, etc. using a background hidden window 67 that mirrors the host application (word processor 56 of Figure 3) (Ex. 2003 at 19-20). The Holt specification further explains that the designer of the mirror application 62 know where the fields are in the host application that are to be set up with tags to correspond to recognized words and that every change made to the host application must be tracked in the background window 67. Sonnier explains that that description of "fields" refers to the use of predefined forms as shown in Figure 5. (Ex. 2005, ¶ 19). The fields are described in the specification as predefined areas of a screen or display (pixel rectangles). (Id.; Ex. 2003 at 22:19 to 23:5). As such, the fields are predetermined and not determined by the mirror application 62.

(Ex. 2005, ¶ 19).

Nowhere in the above description is there an explanation for how the tags will be set up. There is no explicit description that the mirror application determines the text positions of recognized words in the word processor or monitors for changes in the positions of recognized words.

Mitchell argues, with supporting evidence, that a person of ordinary skill in the art would understand that the mirrored embodiment attempts to determine screen-position of the words in the display 70 and not the text positions of the words in the processing application as required by the Group 1 claims. (Paper 73 at 12:21-23). Sonnier explains that the mirrored embodiment utilizes a hidden window 67 for the purpose of replicating changes made in the word processor display 70 by duplicating everything occurring in the host application including window size changes, window scrolling, etc. (Ex. 2005, ¶ 9). According to Sonnier, the mirrored application 62 would have no means to determine the text-position of a recognized word selected by a user in the word processor. (¶¶ 12-13). This is so because a skilled artisan would understand that the Holt Application describes using screen positions of the recognized words and not the text-positions of the words. (Ex. 2005, ¶¶ 16-17). As discussed above in the claim interpretation discussion, the Group 1 claims require determining the text positions of recognized words and not screen positions of recognized words. As such, to the extent that the mirrored embodiment describes an interface application (or second application) that determines recognized

words, it does so based on screen position and not text position as required by the claims.

Mitchell has also sufficiently demonstrated that the mirrored application 62 is not connected to the word processor and therefore does not or cannot itself determine the text position of recognized words or monitor as claimed. Specifically, we credit Sonnier's testimony that in order for the mirrored application 62 to determine the character or text positions of recognized words, the mirrored application would have to communicate with the word processor 56, which it does not. (Ex. 2005 ¶ 18).

Holt argues that its mirrored approach describes an interface application, separate from the target application that functions to determine as claimed. Specifically, Holt argues that Mitchell is incorrect that the mirrored application 62 does not communicate with the word processor 56. Holt argues that a person of ordinary skill in the art would have understood that the mirrored application 62 communicates with the word processor 56 even in the absence of a line in Figure 3 connecting those two components. (Paper 97 at 7-8). In support of the assertion, Holt directs attention to Mr. Porter's testimony. We have already explained why we exclude his testimony. Therefore, without supporting evidence to rely on, Holt's arguments are reduced to attorney arguments which do not take the place of record evidence and therefore fail.

For these reasons, Mitchell has sufficiently demonstrated that the Holt specification does not describe an interface application (second application) for determining or monitoring as claimed. Holt has failed to sufficiently show otherwise.

forms and updates

Mitchell argues that the Holt Application does not describe an interface application that forms link data in its memory, comprising the determined character positions of the recognized words and audio identifiers. (Paper 73 at 14:13-15). Holt's Group 1 claims do not recite that the interface application forms link data *in its memory*. The claims do not require a memory in connection with the interface application.

However, Holt Group 1 claims do require that the interface application forms link data linking audio data to the recognized words and that the link data comprises the determined positions of corresponding recognized words. Sonnier testifies that the Holt Application does not describe an interface application that forms link data as claimed. (Ex. 2005, ¶ 36). More specifically, Sonnier explains that the discussion in Holt's specification regarding linking for a tagging embodiment is not specific enough to provide support for the Holt Group 1 claims. The portion of the Holt Specification to which Sonnier refers is as follows:

> A tagger editor 62 is provided which receives word text and related information as shown by line 61. The word text and related information represents a cluster of data or information which needs to be linked in some manner with the word/text/data as it is put into an external application/system/process such a [sic] word processor 56. (Ex. 2003 at 8:8-12).

Mitchell points out that the above description is what Holt pointed to in support of its annotated claims, but that such description is not specific enough. (Paper 73 at 14:19-22). The above describes tagging arrangements where a tagger editor 62 receives word text and related information from the speech recognition

engine 52. (Ex. 2003 at 8:8-9). The word text and related information represents a cluster of data or information which needs to be linked in "some manner" with the word/text/data as it is put into an external application. (Ex. 2003 at 8:9-11). Even assuming the above means that it is the tagger editor 62 that links the word text and related information, the above passage does not describe the "manner" in which the linking is achieved or the content of the link data, e.g., that the link data comprises audio identifiers and determined positions of corresponding recognized words.

The other portion of the Holt Specification to which Sonnier refers and to which Holt pointed to in support of its annotated claims is as follows:

> The information from the recognition engine 52 will now be described in more detail. In the case of the IBM recognition engine, the resulting information is referred to as a "tag". The tag is basically (1) a milliseconds index or time code pointing into a "PCM" audio file, (2) a unique identifier, and (3) utterance number. (Ex. 2003 at 10:10-13).

We credit Sonnier's testimony that the above passage does not describe an interface application that forms link data as claimed, but rather describes the data that comprises the audio tag received from the speech engine [information that is formed prior to being passed to the tagger editor]. (Ex. 2005, ¶¶ 36-37). Sonnier further testifies that a person of ordinary skill in the art reading the Holt Application would not conclude that it describes an interface application that forms link data as recited in the Group 1 claims. (Id.). Mitchell has sufficiently demonstrated that the Holt Application does not provide written description support for an interface application that forms link data linking audio data to the

recognized words and that the link data comprises the determined positions of corresponding recognized words.

The Group 1 claims also require the interface application to update the link data in response to monitored changes in positions of the recognized words. As explained above, Mitchell has sufficiently demonstrated that the interface application 62 in the tagging embodiments is not described in the Holt Application as monitoring changes in the positions of the recognized words. For similar reasons already explained, Mitchell has sufficiently demonstrated that the tagging embodiments do not describe an interface application that monitors for changes in positions of the recognized words and therefore the tagging embodiments cannot update link data in response to monitored changes.

Mitchell has also sufficiently demonstrated that Holt's specification with respect to the mirrored embodiment does not describe an interface application that forms link data linking audio data to the recognized words and that the link data comprises the determined positions of corresponding recognized words. Mitchell argues that since the mirrored application 62 does not store the positions of the recognized words in the hidden window 67 or elsewhere, it does not form the recited link data and likewise cannot update that data in response to monitored changes. (Paper 73 at 13:1-4). The claims require that the link data comprises the determined positions of the corresponding recognized words. For reasons already provided, a person of ordinary skill in the art would understand that the mirrored embodiment does not describe that the text or character positions of recognized words are determined. Moreover, there is no description that the link data is formed comprising audio data and determined positions of corresponding

recognized words. Also, because the mirror application 62 does not monitor for changes as discussed above, the mirror application cannot update, since the updating is based on the monitored changes in positions of recognized words, all performed by the interface application. Thus, we credit Sonnier's testimony that the Holt application does not describe that the mirrored application forms link data or updates link data as recited in Group 1 claims. (Ex. 2005, ¶ 32).

Holt argues that its application discloses an interface application that forms link data linking the audio data to recognized words, directing attention to the two paragraphs discussed above. (Paper 97 at 14:15-22). We have already explained why those two paragraphs do not describe an interface application that forms link data as claimed. Holt has not directed attention to reliable evidence as to why Mitchell's arguments in that regard are incorrect. We exclude Todd Porter's testimony. Thus, we are not persuaded by Holt's attorney arguments.

We are also not persuaded by Holt's arguments that the Holt application with respect to the mirrored embodiment describes updating the link data in response to monitored changes in positions of the recognized words. (Paper 97 at 14:23 to 15:1 and 15:18-23). As discussed above, one of ordinary skill in the art would not have understood that the mirrored embodiment could be combined with the described tagging embodiments. Thus, we are not persuaded by Holt's arguments, since Holt's arguments are premised on the incorrect assumption that the mirrored embodiment may be combined with the described tagging embodiments. In addition, we are not persuaded by the argument that the mirrored application updates as claimed even if the different embodiments could be combined.

The Holt specification does not explicitly describe that the mirrored application 62 updates as claimed. Holt appears to recognize this and argues that the interface application in the mirrored embodiment functions to update, directing attention to Porter's third declaration. Porter's testimony in its entirety is excluded and therefore Holt's argument necessarily fails.

Moreover, we have already explained why the recited function of the interface application being performed by the word processor does not meet the requirement of the function being performed by an interface application. Therefore we find Holt's arguments at page 15, lines 13-23 unavailing.

For these reasons, Mitchell has sufficiently demonstrated that the Holt specification does not describe an interface application (second application) for forming or updating as claimed. Holt has failed to sufficiently show otherwise.

Group 2 – Holt claims 82-86

Mitchell characterizes the Holt Group 2 claims as requiring an interface application that: (1) receives the speech-recognition data including the recognized words, (2) outputs the recognized words to a computer-related application to allow the processing of those words as input text, and (3) independent of the computer-related application, determines positions of the recognized words in the computer-related application. (Paper 73 at 6:3-7).

Mitchell argues, with supporting evidence, that Holt's specification, as originally filed, does not provide written description support for an interface application that determines the positions of the recognized words in

a processing application program in a manner that is independent of that application as claimed. (Paper 73 at 15:19 to 16:12). For the reasons that follow, Mitchell has met its burden of proving, with supporting evidence, that Holt's involved specification, as originally filed, does not provide written description support for Holt claims 82-86, e.g., the Group 2 claims.

There is only one independent claim in the Group 2 claims; claim 82. Claim 82 is as follows (with the disputed limitation highlighted):

> A speech-recognition **interface** that enables operative coupling of a speech-recognition engine to a computer-related application, **the interface comprising**:
>
> input means for receiving speech-recognition data including recognized words;
>
> output means for outputting the recognized words into a computer-related application to allow processing of the recognized words as input text, including changing positions of the recognized words; and
>
> **means, independent of the computer-related application, for determining positions of the recognized words in the computer-related application.**

At the outset, we note that Mitchell has challenged this claim as being indefinite, since there is allegedly no corresponding structure for an interface with a "means," independent of the computer-related application, for determining positions of the recognized words in the computer-related application. (Paper 74 at 11; Mitchell Motion 3). However, for this motion, the issue is whether Holt has written description support for the function of the means, which is part of the interface. In other words, Mitchell does not challenge, in connection with this motion, that Holt does not have written description support for an interface that has

a means, but rather that Holt does not have written description support for an interface that functions, independent of the computer-related application, for determining positions of the recognized words in the computer-related application. Therefore, our focus is on whether Holt has written description support for an interface that functions as claimed.

Mitchell's arguments at page 16, line 13 to page 17, line 14 are not persuasive with respect to the Group 2 claims. Claim 82 does not recite that the interface application forms link data, etc. Therefore, the argument that the Holt application does not describe forming link data is not persuasive for the Group 2 claims.[7] Moreover, we are not persuaded by Mitchell's arguments that there is not written description support for the input and output limitations recited in the Group 2 claims. (Paper 73 at 16:21-22). This argument is not well articulated and difficult to follow. Mitchell seems to suggest that the tagging embodiments do describe the input and output functions. Indeed, Mitchell acknowledges that the tag editor 62 sends the recognized words and embedded tags to the word processor 56 and thus must output "the recognized words into a computer-related application." Moreover, the tagger editor 62 is seen as receiving word text 61 from the speech recognition engine. Therefore, it is not clear why this does not meet the claimed input for receiving speech recognition data including recognized words.

Mitchell has, however, sufficiently demonstrated that the Holt Application does not describe an interface that determines the text or character positions of

[7] As stated earlier in this opinion, the dependent claims stand or fall together with their respective independent claims. To the extent that Mitchell argues that one of Holt's dependent claims in this group recites the forming limitation, Mitchell has not clearly articulated that position. Rather, Mitchell argues that all of the claims

recognized words in a computer-related application. The analysis is the same with respect to the Group 1 determining limitation described above.

Holt argues that its mirrored approach determines positions of recognized words in a manner that is independent of the computer application (Paper 97 at 16:8-10). Holt's arguments are similar to the arguments presented, and found not to be persuasive, with respect to the Group 1 claims. The analysis with respect to the Group 2 claims is the same.

For these reasons, Mitchell has sufficiently demonstrated that the Holt specification does not describe an interface for determining as claimed in the Group 2 claims. Holt has failed to sufficiently show otherwise.

Group 3 – Holt claims 87-92

Mitchell characterizes the Holt Group 3 claims as requiring an interface application that: (1) receives the recognized words, (2) inputs or passes the recognized words into a processing application program, (3) forms link data linking the audio data to the recognized words, said link data comprising the audio identifiers and information identifying the corresponding recognized words, and (4) compares the identity of a selected word with said link data to identify any corresponding audio. (Paper 73 at 6:8-13).

Mitchell argues, with supporting evidence, that Holt's specification, as originally filed, does not provide written description support for an interface application that performs the four identified functions outlined immediately above. (Paper 73 at 16-19).

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in Group 2 recite this feature, when clearly they do not.

Claim 87 is representative of the group and is as follows (with the disputed limitations highlighted):

> Data processing apparatus comprising:
>
> input means for receiving recognition data from a speech recognition engine and corresponding audio data, said recognition data including a string of recognized words and audio identifiers identifying audio components corresponding to each of the recognized words;
>
> processing means for implementing **an interface application program** which **receives the input recognized words, inputs the recognized words into a processing application program** to process the input recognized words to cause the recognized words to be moved, and **forms link data linking the audio data to the recognized words, said link data comprising the audio identifiers and information identifying the corresponding recognized words**;
>
> display means for displaying the words received and processed by said processing application program;
>
> user operable selection means for selectively identifying a word in the displayed words, **wherein said interface application program is operative to compare the identity of the selected word with said link data to identify any corresponding audio component**; and
>
> audio playback means for playing back any identified corresponding audio component.

Mitchell has challenged the above claim as being indefinite, since there is allegedly no corresponding structure for the "processing means" for implementing an interface application program as claimed. (Paper 74 at 18; Mitchell Motion 3). However, for this motion, the issue is whether Holt has written description support for the function of the interface application program. The focus is on whether Holt does have written description support for an interface application program that functions as claimed.

Mitchell's arguments that there is not written description support for the input and output limitations recited in the Group 3 claims is not persuasive for the same reasons provided above with respect to the Group 2 claims. (Paper 73 at 16:21-22).

Mitchell has, however, sufficiently demonstrated that the Holt Application does not describe an interface application program that is operative to compare the identity of a selected word (by a user) with said link data to identify any corresponding audio component. For reasons already discussed, Mitchell has sufficiently demonstrated, with supporting evidence, that for the tagging embodiments, the tagger editor does not store the recognized words and the tags because the word processor file and word processor stores and maintains the association between the recognized words and their embedded tags whenever the words are moved. Mitchell has also sufficiently demonstrated that for the mirrored embodiments, there is not an interface application program that stores the information that identifies the recognized words or tags. Mitchell demonstrates that the skilled artisan would conclude that Holt does not have an interface application program that compares a selected word with tags (stored link data).

Mitchell has also sufficiently demonstrated that neither the embedded tagging embodiment nor the mirrored embodiment describes that the interface application program, such as the tagger editor 62 (Fig. 2) or mirror application 62 (Fig. 3), forms link data that includes "information identifying the corresponding recognized words." Sonnier sufficiently explains, and his testimony is consistent with Holt's specification, that in neither the mirrored embodiment nor the tagging embodiments is the linking of words with audio made with information identifying

the corresponding word. (Ex. 2005, ¶¶ 37-39). The missing part is the "information." It must be something other than the word itself. Holt claim 87 is identical to Mitchell claim 69. Viewing the "information" in light of Mitchell's specification, it is clear that the information is something other than the corresponding word. (Ex. 2005, ¶ 38, citing Ex. 2001, col. 6:66 to col. 7:15, Figure 4).

Holt argues that the Holt specification does describe an interface application that forms link data that includes information identifying the corresponding recognized words. (Paper 97 at 19:8-11). Holt directs attention to that portion of its specification that states that the word text and related information represents a cluster of data or information which needs to be linked in some manner with the word/text/data as it is put into an external application/system/process such as a word processor. We have already explained why that description does not provide support for that which is claimed. In the context of the Group 3 claims, the analysis is similar.

The description to which Holt directs attention is directed to embedded tagging arrangements where a tagger editor 62 receives word text and related information from the speech recognition engine 52 (Ex. 2003 at 8:8-9). The word text and related information, e.g., the audio info (Figure 2 at 64), represents a cluster of data or information which needs to be linked in "some manner" with the word/text/data as it is put into an external application. (Ex. 2003 at 8:9-11). Even assuming this to mean that it is the tagger editor 62 that links the word text with the audio data, the above passage does not describe the "manner" in which the linking

is achieved or the content of the link data, e.g., that the link data comprises audio identifiers and information identifying the corresponding recognized words.

Holt also argues that its application does describe an interface application that compares the identity of the selected word with said link data to identify any corresponding audio component. (Paper 97 at 19:21 to 20). Holt argues that its link data comprises the audio identifiers and the determined positions of corresponding recognized words. We disagree for reasons already provided. Holt has not sufficiently explained, with reliable supporting evidence, how the interface application compares the identity of the selected word with the link data to identify any corresponding audio component.

For all of the above reasons, Mitchell has sufficiently demonstrated that Holt's involved claims are unpatentable under the written description requirement of 35 USC 112, ¶ 1.

Mitchell Motion 2 is GRANTED.

Holt Motion 6

Holt filed a responsive motion to add a claim 95, which is a copy of Mitchell claim 1. (Paper 82). The motion is responsive to Mitchell Motion 4; not Mitchell Motion 2. (Paper 48 at 3:5-6; Paper 82). That is, the proposed claim 95 contains all of the language that Mitchell argues through its Motion 2 is unsupported. Thus, it is clear that the Motion 6 seeks to overcome the patentability problem raised in Mitchell Motion 4 (a "135(b) problem"); not the patentability problem raised in Mitchel Motion 2. *See* SO ¶ 208.5.1 (If a claim is added to overcome a patentability problem raised in a motion, the motion to add the claim must explain why the proposed claim would overcome the problem). We decline to add the

claim to the interference because it suffers from the same patentability problem Mitchell identified in connection with its Motion 2, which we grant. For all of these reasons, Holt Motion 6 is DENIED.

Mitchell Motions 3-6 and Holt Motions 1-5

Mitchell Motion 2 is granted and therefore Holt lacks standing to continue in this interference. Moreover, Holt Motion 6 to add to the interference a Holt claim 95 is DENIED.

Accordingly, Mitchell Motions 3-6 and Holt Motions 1-5 are herein DISMISSED.

D. Order

It is

ORDERED that Mitchell Motion 2 is GRANTED;

FURTHER ORDERED that Mitchell Motions 3-6 are DISMISSED;

FURHTER ORDERED that Mitchell Motion 7 is GRANTED-IN-PART and DISMISSED-IN-PART;

FURTHER ORDERED that Holt Motion 6 is DENIED; and

FURTHER ORDERED that Holt Motions 1-5 are DISMISSED.

cc (via e-mail):

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